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09/937,784	01/28/2002	Daniel Henry Densham	GJE-78	7070
23557	7590	11/28/2005	EXAMINER	
SALIWANCHIK LLOYD & SALIWANCHIK A PROFESSIONAL ASSOCIATION PO BOX 142950 GAINESVILLE, FL 32614-2950			SISSON, BRADLEY L	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/937,784

Applicant(s)

DENSHAM, DANIEL HENRY

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Supplemental Office Action***

1. The following is a supplemental Office action to that mailed 18 November 2005. The period for responding is restarted and runs from the mailing date of the instant Office Action.

### ***Finality Withdrawn***

2. The finality of the prior Office action is hereby withdrawn.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 October 2005 has been entered.

### ***Specification***

4. The specification is objected to as documents have been improperly incorporated by reference. In particular, the specification states:

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[0065] Throughout this application, various publications, patents, and patent applications have been referred to. The teachings and disclosures of these publications, patents, and patent applications in their entireties are hereby incorporated by reference into this application to more fully describe the state of the art to which the present invention pertains.

5. Such omnibus language fails to specify what specific information applicant seeks to incorporate by reference and similarly fails to teach with detailed particularity just where that specific information is to be found in each of the cited documents.

6. Attention is also directed to MPEP 608.01(p)I, which, in pertinent part, is reproduced below:

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated may be found. (Emphasis added)

7. As set forth In *Ex parte* Raible, 8 USPQ2d 1707, (BPAI, 1998)

The examiner is of the opinion that the general incorporation by reference of the Bentley disclosure in appellant's specification is insufficient to support the specific disputed limitations of the present claims in the manner required by section 112 of the statute. We agree

8. \*

We believe that the doctrine of incorporation by reference is of no avail to appellant in this regard since there is no specific indication in the instant specification of the particular features disclosed by Bentley which correspond to those intended for use in the here-claimed device; nor does the specification identify the specific portions of the patent which appellant may have intended to rely upon to supplement his disclosure. The purpose of incorporation by reference in an application of matter elsewhere written down is for economy, amplification, or clarity of exposition, by means of an incorporating statement clearly identifying the subject matter which is incorporated and where it is to be found. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144, (CCPA 1973).

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9. Accordingly, the cited documents are not considered to have been properly incorporated by reference and as such, have not been considered with any effect towards their fulfilling, either in part or in whole, the enablement, written description, or best mode requirements of 35 USC 112, first paragraph.

***Claim Rejections - 35 USC § 112***

10. Claims 7-20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Attention is directed to the decision in *University of Rochester v. G.D. Searle & Co.* 68 USPQ2D 1424 (Fed. Cir. 2004) at 1428:

To satisfy the written-description requirement, the specification must describe every element of the claimed invention in sufficient detail so that one of ordinary skill in the art would recognize that the inventor possessed the claimed invention at the time of filing. *Vas-Cath*, 935 F.3d at 1563; see also *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 [41 USPQ2d 1961] (Fed. Cir. 1997) (patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”); *In re Gosteli*, 872 F.2d 1008, 1012 [10 USPQ2d 1614] (Fed. Cir. 1989) (“the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed”). Thus, an applicant complies with the written-description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572.

11. For convenience, claims 7, 14, and 22, the only independent claims currently pending, are reproduced below.

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**Claim 7 (Previously presented):** A method for sequencing a polynucleotide, comprising the steps of:

- (i) reacting a target polynucleotide with a helicase enzyme or a primase enzyme, under conditions suitable for enzyme activity; and
- (ii) detecting the interaction between the enzyme and the nucleotide on the target polynucleotide, to thereby determine the sequence of the target polynucleotide, the detection being carried out by measuring a change in, or absorption of, radiation that occurs during the interaction.

**Claim 14 (Previously presented):** A method for sequencing a polynucleotide, comprising the steps of:

- (i) reacting a target polynucleotide with a helicase enzyme and a primase enzyme under conditions suitable for enzyme activity; and
- (ii) detecting the interaction between the enzymes and the nucleotide on the target polynucleotide, to thereby determine the sequence of the target polynucleotide, the detection being carried out by measuring a change in, or absorption of, radiation that occurs during the interaction.

**Claim 22 (Previously presented):** A method for sequencing a polynucleotide, comprising the steps of:

- (i) reacting a target polynucleotide with a helicase enzyme under conditions suitable for enzyme activity; and
- (ii) detecting the interaction between the helicase enzyme and the nucleotide on the target polynucleotide, to thereby determine the sequence of the target polynucleotide, the detection being carried out by measuring a change in, or absorption of, radiation that occurs during the interaction.

12. As is evident above, each of the three independent claims requires one to measure a change in, or absorption of, radiation that occurs during the interaction of "a target polynucleotide with a helicase enzyme or a primase enzyme." It is noted with particularity that

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none of these methods require that any radiation be inputted to the reaction, rather, only that a change, if any, be measured.

13. As presently worded, the claimed method fairly encompasses determining the nucleotide sequence of a cell, e.g., the human genome, when the nucleic acid is still within a cell and the cell is subjected to radiation such that that associated with daylight. The specification, however, is silent as to how such a feat could be accomplished.

14. Additionally, the claimed method fairly encompasses determining the complete nucleotide sequence of any nucleic acid, e.g., intact chromosomes, when no radiation is used and accordingly, there is no change in radiation emission or absorption.

15. Further, the claimed method has been construed as encompassing performing the claimed method where all reactants are floating in solution and the period for enzymatic activity is intermittent or transient.

16. Likewise, the claimed method fairly encompasses performing the method where the enzyme is immobilized and unincorporated reactants are not removed from the reaction site.

17. A review of the disclosure finds but one example, and then the statement that "DNA sequencing was conducted by the method described in WO-A-99/0515, using the apparatus shown in Fig. 1, but using only one focusing assembly (5) for pulsing monochromatic light into the cell."

18. A review of WO-A-99/0515 find the following disclosure at page 14, bridging to page 15:

DNA Sequencing

Figure 1 shows a SPR sensing system and fluidic cell (7), having a means for applying electromagnetic radiation (1) to a sensor chip (2) with an immobilised polymerase enzyme (3) at the sensor surface, an inlet (4) for introducing the different nucleotides into the cell and two

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focusing assemblies (5) and (6) for pulsing monochromatic light into the cell. The different nucleotides are introduced into the fluidic cell (7) at a flow rate of 30  $\mu\text{l}/\text{min.}$ , at a temperature of 25°C and a data collection rate of 10 Hz. As the nucleotides pass the focusing assembly (5), monochromatic light at a wavelength of 260 nm is pulsed to remove the blocking group at the 5' position. The nucleotides then flow over the sensor chip (2) and contact the target polynucleotide/ polymerase complex (3) which is held in place by the  $\beta$ -dimer sub-assembly. Since the 3' position on the primer sequence is free to react, polymerisation may take place as a nucleotide is incorporated onto its complement on the target polynucleotide. This incorporation is then detected by the monochromatic p-polarised light of the SPR device. No further polymerisation occurs, since the incorporated nucleotide has a blocking group at the 3, position. Monochromatic light of wavelength 360 nm is then pulsed by the focusing assembly (6) at the site of polymerisation. The high flow rate in the fluidic cell ensures that nucleotides not bound to the polymerase are removed from the cell before sufficient energy has been absorbed to release their 3' blocking groups.

19. The specification of the instant application, and the relevant portion of the WO document do not teach or even reasonably suggest practicing the now claimed method where no radiation is used, where the radiation is constant, where the reactants are either all immobilized or in solution, and where non-incorporated reactants are left at the site of incorporation.

20. The specification has not been found to teach using multiple types of enzymes in the context of a single assay (limitation of claims 14-20), or for that matter, the use of an enzyme other than a "polymerase enzyme." Further, neither the instant disclosure nor the sequencing method disclosed in the WO document fairly teach in such full, clear, and concise language how the claimed method is to be practiced with surface plasmon resonance, nuclear magnetic resonance. While the specification may provide literal support for other theoretical or potential embodiments, the disclosure provided lacks the detailed teaching that reasonably suggests that applicant had possession of these alternative embodiments.

21. It appears that applicant is attempting to satisfy the written description requirement of 35 USC 112, first paragraph, through obviousness. Obviousness, however, cannot be relied upon



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for satisfaction of the written description requirement. In support of this position, attention is directed to the decision in *University of California v. Eli Lilly and Co.* (Fed. Cir. 1997) 43 USPQ2d at 1405, citing *Lockwood v. American Airlines Inc.* (Fed. Cir. 1997) 41 USPQ2d at 1966:

22. Recently, we held that a description which renders obvious a claimed invention is not sufficient to satisfy the written description requirement of that invention.

23. For the above reasons, and in the absence of convincing evidence to the contrary, claims 7-20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Response to argument

24. In the response received 25 October 2005, hereinafter the response, applicant's representative make numerous assertions as to what one of ordinary skill in the relevant art would have known and been capable of doing.

25. This argument has been fully considered and has not been found persuasive. Attention is directed to MPEP 2145.

Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art.

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

26. The Office action has set forth specific reasons as to why the originally filed disclosure does not fulfill the written description requirement. No convincing evidence has been presented

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by applicant's representative as to the level of skill, and to what one of ordinary skill in the art would have been capable of doing. Therefore, absent convincing evidence to the contrary, claims 7-20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

27. Claims 7-20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As set forth in *Enza Biochem Inc., v. Calgene, Inc.* (CAFC, 1999) 52 USPQ2d at 1135, bridging to 1136:

To be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.' " *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir. 1997) (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)). Whether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed, see *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).... We have held that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, but that such experimentation must not be "undue." See, e.g., *Wands*, 858 F.2d at 736-37, 8 USPQ2d at 1404 ("Enablement is not precluded by the necessity for some experimentation . . . However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.' ") (footnotes, citations, and internal quotation marks omitted). In *In re Wands*, we set forth a number of factors which a court may consider in determining whether a disclosure would require undue experimentation. These factors were set forth as follows: (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. *Id.* at 737, 8 USPQ2d at 1404. We have also noted that all of the factors need not be reviewed when determining whether a disclosure is enabling. See *Amgen, Inc. v. Chugai Pharm. Co., Ltd.*, 927 F.2d 1200, 1213, 18 USPQ2d 1016, 1027 (Fed. Cir. 1991) (noting that the *Wands* factors "are illustrative, not mandatory. What is relevant depends on the facts.").

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28. As set forth above, each of the three independent claims require one to measure a change in, or absorption of, radiation that occurs during the interaction of "a target polynucleotide with a helicase enzyme or a primase enzyme." It is noted with particularity that none of these methods require that any radiation be inputted to the reaction, rather, only that a change, if any, be measured. The specification, however, does not teach how such a feat is to be accomplished.

29. As presently worded, the claimed method also fairly encompasses determining the nucleotide sequence of any and all chromatin found within any human cell, e.g., the human genome, mRNA, tRNA, rRNA as well as mitochondrial DNA and RNA, when the nucleic acid is still within a cell and the cell is subjected to radiation such that that associated with daylight as well as when exposed to any other form of electromagnetic radiation. The specification, however, is silent as to how such embodiments could be accomplished.

30. Additionally, the claimed method fairly encompasses determining the complete nucleotide sequence of any nucleic acid, e.g., intact chromosomes, when no radiation is used and accordingly, there is no change in radiation emission or absorption.

31. Further, the claimed method has been construed as encompassing performing the claimed method where all reactants are floating in solution and the period for enzymatic activity is intermittent or transient.

32. Likewise, the claimed method fairly encompasses performing the method where the enzyme is immobilized and unincorporated reactants are not removed from the reaction site.

33. The claimed method fairly encompasses determining the nucleotide sequence of a limitless number of different "nucleic acids" in a simultaneous manner, where the "nucleic acid" is of any length and is in the same reaction area.

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34. A review of the disclosure finds but one example, and then the statement that “DNA sequencing was conducted by the method described in WO-A-99/0515, using the apparatus shown in Fig. 1, but using only one focusing assembly (5) for pulsing monochromatic light into the cell.” WO-A-99/0515 teaches at page 14, bridging to page 15:

#### DNA Sequencing

Figure 1 shows a SPR sensing system and fluidic cell (7), having a means for applying electromagnetic radiation (1) to a sensor chip (2) with an immobilised polymerase enzyme (3) at the sensor surface, an inlet (4) for introducing the different nucleotides into the cell and two focusing assemblies (5) and (6) for pulsing monochromatic light into the cell. The different nucleotides are introduced into the fluidic cell (7) at a flow rate of 30  $\mu\text{l}/\text{min.}$ , at a temperature of 25°C and a data collection rate of 10 Hz. As the nucleotides pass the focusing assembly (5), monochromatic light at a wavelength of 260 nm is pulsed to remove the blocking group at the 5' position. The nucleotides then flow over the sensor chip (2) and contact the target polynucleotide/ polymerase complex (3) which is held in place by the  $\beta$ -dimer sub-assembly. Since the 3' position on the primer sequence is free to react, polymerisation may take place as a nucleotide is incorporated onto its complement on the target polynucleotide. This incorporation is then detected by the monochromatic p-polarised light of the SPR device. No further polymerisation occurs, since the incorporated nucleotide has a blocking group at the 3' position. Monochromatic light of wavelength 360 nm is then pulsed by the focusing assembly (6) at the site of polymerisation. The high flow rate in the fluidic cell ensures that nucleotides not bound to the polymerase are removed from the cell before sufficient energy has been absorbed to release their 3' blocking groups.

35. Clearly, neither the specification of the instant application, nor the relevant portion of the WO document teach or even reasonably suggest practicing the embodiments recognized above.

36. The situation at hand is analogous to that in *Genentech v. Novo Nordisk A/S* 42 USPQ2d 1001. As set forth in the decision of the Court:

“ ‘[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.’ *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) (‘[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.’). ”

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“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that ‘a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.’) Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

“It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research. (Emphasis added)

37. For the above reasons, and in the absence of convincing evidence to the contrary, claims 7-20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

### ***Double Patenting***

38. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application

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claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

39. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

40. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

41. Claims 7, 8, 11, 13-16, 18, 20, and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,623,929 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of the '929 patent are drawn to a method of sequencing a nucleic acid wherein monochromatic light, a form of electromagnetic radiation, is used to interrogate a nucleotide incorporated into a complementary nucleic acid strand, and thereby determine the nucleotide sequence of the parent strand. Claim 2 specifically teaches using surface plasmon resonance in performance of this method. In view of such disclosures, it would

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have been obvious to one of ordinary skill in the art to develop a method of sequencing nucleic acids where said ordinary artisan uses electromagnetic radiation to identify the nucleotide incorporated into a complementary strand.

42. Therefore, and in the absence of convincing evidence to the contrary, claims 7, 8, 11, 13-16, 18, 20, and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,623,929 B1.

### *Conclusion*

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

44. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

45. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bradley L. Sisson

Primary Examiner

Art Unit 1634

BLS

22 November 2005